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MICHAEL O. SCHEINBERG  
P.O. BOX 164140  
AUSTIN, TX 78716-4140

EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 04/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/300,881

Applicant(s)

James H. Wolfston

Examiner

Andrew J. Fischer

Art Unit

2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-28 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 28, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

Art Unit: 2167

## **DETAILED ACTION**

### ***Acknowledgments***

1. The amendment filed March 5, 2002 (Paper No. 12) is acknowledged.

### ***Election/Restriction***

2. Because the application no longer includes inventions drawing to Group I as defined in Paper No. 7, a restriction between inventions is now improper. Therefore the restriction requirement of Paper No. 7 is hereby withdrawn. The Examiner notes the previous restriction was never made final. If Applicant submits claims directed to or similar to invention I at a later date, the restriction may be reinstated at that time.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings are replete with these errors. The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):
  - a. The “automatically accepting” donations as recited in claims 6 and 21.
  - b. The “automatically publishing” donations as recited in claims 6 and 21.
  - c. The “automatically and immediately making publicly available” as recited in claim 21.

Art Unit: 2167

4. A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. Additionally, the drawing changes required by the Draftsperson on form PTO 948 (see Paper No. 7) are required in response to this Office Action. The objections to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13, 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

a. Claim 13 is indefinite since it does not contain any method steps. While the claims need not recite all of the operating details, a method claim needs at least a positive, active step. *Ex parte Erlich*, 3 USPQ2d 1011, 1017 (B.P.A.I. 1987) (citations omitted).

b. In claim 17, it is unclear if the second "a program" is the same or different from the first "a program." The Examiner interprets the claims to require a single "a program" since nothing in the claim excludes the program from being a single program.

Art Unit: 2167

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 17-21, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Moen et. al. (U.S. 5,864,604). Moen et. al. discloses: a network server (the internet server); a computer program (the operating system); the server communicates over the internet (column 5, lines 47-61); and a world wide web page (inherent in the internet).

10. Claims 17-21, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ziarno et. al. (U.S. 5,895,902)("Ziarno '902").

11. Claims 17-21, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ziarno et. al. (U.S. 5,506,393)("Ziarno '393").

12. The Examiner notes Applicant argues that in reference to the apparatus claims, "they recite *not actions*, but hardware and software . . . . [Emphasis added.]" See Applicant's Amendment 'A', Paper No. 12, "Remarks," section on page 2, lines 13-14.

Art Unit: 2167

13. Functional recitation(s) using the word “for” (e.g. “for communicating with individuals over a computer network” as recited in claim 17) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). For functional language in Applicant’s method claims, see *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 6-12, 16, 21, 22, 27, and 28, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Moen et. al. in view of Herr-Hoymann et. al. (U.S.

Art Unit: 2167

5,727,156). Moen et. al. discloses (in Example 12) automatically accepting donations over a computer network using software and a credit card or alternatively accepting donations by email; totaling donations by a category (inherent since alphabetical is the category most used). Moen et. al. does not directly disclose the automatically publishing the data.

Herr-Hoymann et. al. teaches automatically publishing information to the internet using credit card authorization (column 2, lines 51-54).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moen et. al. as taught by Herr-Hoymann et. al. to include automatically publishing information to the internet. Such a modification would have helped non-profit groups find other donors.

16. Claims 6-12, 16, 21, 22, 27, and 28, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno '902 in view of Herr-Hoymann et. al.

17. Claims 6-12, 16, 21, 22, 27, and 28, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno '393 in view of Herr-Hoymann et. al.

18. Claims 7-9, 11, 12, 22, 27, and 28, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Moen et. al. in view of Herr-Hoymann et. al. It is the Examiner's position that the steps of publishing various contents about the donor is inherent in the combination. However, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of the Moen et. al./Herr-Hoymann et. al. combination with any type of content.

Art Unit: 2167

The missing elements in the Moen et. al./Herr-Hoymann et. al. combination are only found in the nonfunctional descriptive material and are not functionally involved in the steps claimed (i.e. the steps of publishing "information about the donor" such as name or address is in no way dependent upon "the automatically publishing"). In other words, the method steps are performed regardless of the content of the data to be published.

The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).<sup>1</sup>

19. Claims 13-15, 23-26, as understood by the Examiner, are also rejected under 35 U.S.C. 103(a) as being unpatentable over Moen et. al. in view of Herr-Hoymann et. al. The Moen et. al./Herr-Hoymann et. al. combination discloses as discussed above and including "publishing" the information which encourages others to donate by having a potential donor read about the other donors. The Moen et. al./Herr-Hoymann et. al. combination does not directly disclose totaling the amounts. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Moen et. al./Herr-Hoymann et. al. combination to include a total. When lists of dollar amounts are present, totals of the dollar

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<sup>1</sup> The Examiner notes that in claim 13, the content of the published material affects the method steps. In that case, the content contains functional descriptive material.



Art Unit: 2167

value are very well known in the art. Such a modification would have provided a running total of the dollar amounts published.

### *Response to Arguments*

20. Applicant's arguments filed with the amendment on March 5, 2002 (Paper No. 12) have been fully considered but they are not persuasive.

21. Because of Applicant's remarks, the §101 rejection has been withdrawn. The Examiner concurs that Applicant has claimed an apparatus. "Claims in apparatus form conventionally fall into the 35 U.S.C. § 101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Applicant additionally argues that "they recite not actions, but hardware and software that is capable of performing the action." The Examiner agrees. Applicant has not claimed that the software actually *does* anything, only that the software is *capable* of doing something. The Examiner therefore has interpreted the apparatus claims *not* to recite actions.<sup>2</sup>

22. Additionally, Applicant is reminded that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is,

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<sup>2</sup> "The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution." *Rheox, Inc. v. Entact, Inc.*, 61 USPQ2d 1368, 1372 (Fed. Cir. 2002) (citations omitted).

Art Unit: 2167

not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The only positive limitations in claim 17 are “a network sever” and a first “a program.”

23. Regarding the definition of publish, the Examiner had previously relied upon the ordinary and accustom meaning. It is the Examiner’s position that Applicant has now, being his own lexicographer, redefined “publish” to superseded its ordinary and accustom meaning. “Even where the ordinary meaning of the claim is clear, it is well-established that the prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.” *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001) (citations omitted). In accordance with MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology,” the Examiner adopts Applicant’s express definition and has examined the claims with Applicant’s definition. The Examiner thanks Applicant for the clarity in addressing this issue.

24. Other the definition as discussed above and after careful review of the specification and prosecution history, the Examiner is unaware of any additional attempts—either expressly or implicitly—by Applicants to be his own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, other the definition as discussed above, the Examiner starts with the presumption that the remaining claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad*

Art Unit: 2167

*Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>3</sup>

However, if Applicant does desire any additional claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant to expressly indicate the claim limitation at issue<sup>4</sup> and to show where in the specification or prosecution history the limitation is defined. Just as Applicant has defined “publish,” additional definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term

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<sup>3</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

<sup>4</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

Art Unit: 2167

so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>5</sup> The Examiner cautions that no new matter is allowed.

25. The Examiner interprets claims 6-16 and 21-28 as directed to the same embodiment. An election of species is therefore improper at this time. If however its Applicant's position now or in any future arguments that the claims are directed to more than one embodiment, an election of species requirement will most likely follow.

26. The Examiner thanks Applicant for a clean copy of the canceled claims but such copies are never necessary.

### ***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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<sup>5</sup> See also *Vitronics Corp. v. Conceptiontronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”).

Art Unit: 2167


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Ziarno (U.S. 5,887,273), Ziarno (U.S. 6,092,052); Campbell et al (U.S. 6,240,451 B1); and Campbell (U.S. 5,694,596).

29. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJF  
March 29, 2002

  
ANDREW J. FISCHER  
PATENT EXAMINER  
3/29/02

  
ROBERT P. OLSZEWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600-2100